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10/507,211

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Miki Murakami

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

05/04/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/507,211 | Applicant(s) MURAKAMI ET AL. | |
| | Examiner JOHN M. WINTER | Art Unit 3685 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on February 13, 2009 is hereby acknowledged.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 are drawn to licensed usage of content, classified in class 705 subclass 59.
 - II. Claims 10 are drawn to usage by authorized user, classified in class 726 subclass 28.
2. Inventions I, II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the subcombination as claimed in invention I such as determining that the client is legitimate.

Examiner notes that would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.
3. Via paper filed on February 13, 2009 a provisional election was made without traverse to prosecute the of Invention I, claims 1-9. Affirmation of this election must be made by

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applicant in replying to this Office action. Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Claims 1-9 have been examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to

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meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

6. In this particular case, claim 9 fails prong (1) because the “tie” (e.g. downloading content) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claims 1 and 8 are the claimed invention is directed to non-statutory subject matter.

Claims 1 and 8 state “a content delivery system” and “an information processing apparatus” respectively, however in the body of the claim, features such as “registering means” and license granting mean” are described in the specification (at page 21) as “executable client applications” and therefore the elements of the claimed invention are directed towards “software per se” and as such are non-statutory.

7. Claims 2-7 are dependant upon claim 1 and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 5 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 contains the language “client and/or any “which is indefinite

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Claims 5 and 7-9 contain the term “legitimate” it is unclear by what law or standard “legitimate” use or status is ascertained.

Claim 7 contains the language “said fee-charging means makes a difference in charges between a case” it is unclear what type of “difference” is made.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al. (US Patent 5,629,980) in view of Cooper et al (US Patent 5,563,946).

10. As per claim 1,

Stefik et al. ('980) discloses a content delivery system for delivering content to a client of a user who possesses at least two clients, each of said clients using content legitimately based on an acquired license, said content delivery system comprising:
customer-related information managing means for managing said customer-related information; content providing means which, in response to a request from any one of said clients, provides content to the requesting client (Figure 18, Column 11, lines 1-14 –

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description of "work state information"),

first license granting means which, in response to a request from the client having acquired the content from said content providing means, grants said requesting client a license for the acquired content; (Column 9, line 7 – Discussion of “Structure of digital works”)

second license granting means which, after said user has moved the content from one client to another in the possession of the same user, grants said user a license for the moved content.(Column 11, line 30, Discussion of attaching usage rights to digital works, -- a second (child) license can be derived from the first one.)

11. Stefik et al. ('980) does not explicitly disclose “registering means for registering each of said clients of said user in order to acquire customer-related information;
Cooper et al. ('946) discloses “registering means for registering each of said clients of said user in order to acquire customer-related information “(Figure 9) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Stefik et al. ('980) method with the Cooper et al. ('946) method in order to keep a persistent record of clients.

12. As per Claim 2,

Stefik et al. ('980) discloses a content delivery system according to claim 1, wherein said customer-related information managing means manages a table of correspondences between leaf ID's and client ID's, a table of correspondences between client ID's and user ID's, a table of correspondences between content ID's and license

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ID's, a table of correspondences between user ID's and the content ID's of downloaded content, and a table of correspondences between user ID's and the license ID's of downloaded licenses.(Figures 14 and 15)

13. As per Claim 3,

Stefik et al. ('980) discloses a content delivery system according to claim 1, wherein said customer-related information managing means updates said customer-related information every time said content providing means provides content to a client and/or any one of said first and said second license granting means grants a license to a client.(Column 35, lines 30-60)

14. As per Claim 4,

Stefik et al. ('980) discloses a content delivery system according to claim 1, wherein, in response to a request from a client for a license, said second license granting means acquires the requested license from said first license granting means and returns the acquired license to the requesting client. (Column 7, lines 5-37, Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim

because they can always be omitted.)

15. As per Claim 5,

Stefik et al. ('980) discloses a content delivery system according to claim 4, wherein said second license granting means, by querying said customer-related information managing means, verifies that said requesting client is legitimate, that the same user possessing said requesting client is in possession of another client registered with said first license granting means, and that the requested license has already been granted to said another client by said first license granting means. (Column 13, lines 11-40)

16. As per Claim 6,

Stefik et al. ('980) discloses a content delivery system according to claim 1 further comprising fee-charging means for performing a fee-charging process regarding the client to which a license has been granted. (Figure 15)

17. As per Claim 7,

Stefik et al. ('980) discloses a content delivery system according to claim 5 wherein said fee-charging means makes a difference in charges between a case in which said first license granting means grants a license to a client downloading content, and a case in which said second license granting means grants a license to another client of the

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same user in possession of said downloading client. (Figure 15)

18. Claims 8 and 9 are not patentable distinct from claims 1-7 and are rejected for at least the same reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JMW

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685